



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,457	03/28/2001	Michael J. Borg	10006799-1	6674

7590 06/16/2005
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,457

Applicant(s)

BORG ET AL.

Examiner

Tan Dean D. Nguyen

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23, 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The amendment filed 3/20/05 has been entered. Claim 24 has been canceled.

Claims 1-23, 25 remain active.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 20-23, 25 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over HARDMAN et al (US 2002/007 5145).

As for Independent Database claims 20, 25, which deals with a database comprising a plurality of records, HARDMAN et al discloses a database comprising a plurality of record, each record further comprising:

(a) a customer field that contains a value that uniquely identifies a customer {see Fig. 29, [0107-0122]};

(b) a product field that contains a product identifier that identifies a product used by the customer {see Figs. 31, 25, [0142-0149]};

(c) a product information field that contains information related to the product identified in the product field {see Figs. 32, [0142-0149]};

(d) a customer information field that contains information related tot the customer identified in the customer field {see Fig. 29, 0145-0151]};

(e) a product usage field that contains information related to how the product identified in the product field is used by the customer identified in the customer field {see Figs. 25-29, [0107, 0108, 0110, 0112, 0150-0151]}. As for the limitation of the product is a printing device or information is obtained from a printing device, or the type of information/data, these are merely non-functional data on a storage device, and carry no patentable weight.

Art Unit: 3629

Alternatively, on [0309, 0145-0149], HARDMAN et al teaches the collection, monitoring and management of other relevant embodiments if desired (besides the related tire tag), therefore, it would have been obvious to collect other relevant information if desired such as about the customer information.

As for dep. claim 21 (part of 20), which deals with instruction to follow when certain information meets certain criteria, this is taught in [0024-0235]. Moreover, these are non-functional data on a storage device and carry no patentable weight.

Alternatively, the application of other well known business instruction, i.e. free replacement of product or material for malfunction within the 1st year of normally guaranteed performance, would have been obvious to a skilled artisan.

As for dep. claim 22 (part of 20), which deals with further limitation of a field comprising information related to a history of communications with the customer, this is shown in [0119, 0024, 0309], Figs. 25, 29. Moreover, these are non-functional data on a storage device and carry no patentable weight. Alternatively, the collection of other desired information would have been obvious in view of the teachings of [0309, 0313, 0119], absent evidence of unexpected results.

As for dep. claim 23 (part of 20), which deals with further limitation of a field comprising information about other products purchased by the customer, this is shown in [0309], Figs. 29-31. Moreover, these are non-functional data on a storage device and carry no patentable weight. Alternatively, the collection of other desired information would have been obvious in view of the teachings of [0309, 0313, 0119].

Art Unit: 3629

5. **Claims 1-9 (method¹), 16-19 (method²), 10-15 (apparatus¹), 20-23, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over HARDMAN et al in view of KLINEFELTER et al or vice versa.**

As for Independent **Method¹ Claim 1**, HARDMAN et al fairly discloses an electronic tag (Radio Frequency (RF)) communication management system/method comprising:

(a) retrieving data from component memory (tag or memory tag) of a replaceable component (i.e. a tire) from a device (i.e. vehicle) used by a customer {see Figs. 12, 25, [0107]}

(b) storing the data in a customer database {see Figs. 12, 25, [0108, 0111]}

(c) associating the data with the customer; {see Figs. 29, "User ID", "First name", "Telephone number", and [0145-0150]} and

(d) accessing the data in the customer database to assist the customer with solving problems related to the device {see Figs. 20, 23, 24, 25, 26, 31 "Editing Vehicle", [0003: "must be regularly maintained to maximize device efficiency", [0120: "transmit alarm signals when a parameter is out of range]; [0205: "function satisfactory within the specified load carrying capacity", and especially [0234: "need of service, ..., can be attended to immediately, "service can be directed to only problem tires and efficiency in service can be achieved. ... identification of problems early.. for evaluation.... to alarm personnel to the need for service to a particular tire], [0235: Fig. 20... an unacceptable condition illustrating that a problem has occurred with that tire]}. As for the limitation of "printing device" data, this is non-functional language and carry

Art Unit: 3629

no-patentable weight since it's merely non-functional data on a storage device.

Therefore, HARDMAN et al fairly discloses the claimed invention except for the difference in the type of data due to different source/origination of the replaceable component, i.e. from a printing device vs. from a moving device or vehicle. In other word, HARDMAN et al fairly teaches the claimed invention except for the difference in the type of device, i.e. a printing device.

In a method and apparatus for communicating between a printer/printing device and supplies using electronic memory tag (Radio Frequency (RF) communication, KLINEFELTER et al teaches the retrieving of data from component memory (tag/memory tag) of a replaceable component (toner/ink cartridge) from a device (i.e. printing device) used by a customer {see Figs. 9, 7 or col. 5, line 5 to col. 6, line 61, col. 1, lines 5-18} for diagnostics or reordering information {see col. 6, line 15}. It would have been obvious to a skilled artisan in the electronic memory tag (Radio Frequency (RF) communication technology to modify the process of HARDMAN et al by applying the same steps of electronic tag (Radio Frequency (RF)) communication management system/method to a printing device as taught by KLINEFELTER et al, which has a similar goal of communicating between a printer/printing device and supplies using electronic memory tag (Radio Frequency (RF) communication, as mere applying the same electronic memory tag (Radio Frequency (RF) communication of a replaceable components to other device to achieve similar communication results. Clearly, the mere applying the same essential retrieving, storing, associating and accessing the data steps from a memory tag of a replaceable component to/of any other device would have

Art Unit: 3629

been obvious to a skilled artisan since the type or different function of the device is not critical and any device can be used.

Alternatively, it would have been obvious to modify the teachings of KLINEFELTER et al by carrying out the further steps of (b)-(d) as taught by HARDMAN et al above to assist the customer with solving problems (diagnostics) related to the device as shown above. As indicated above, the type or different function of the device is not critical and the same RF communication management method and system can be used for any device that has replaceable component containing RF tag.

As for dep. claims 2-3 (part of 1), which deals with well known information/data parameter, i.e. information/data about the device and its usage, these are non-essential to the claimed invention and are fairly taught in HARDMAN et al /KLINEFELTER et al as shown in HARDMAN et al Fig. 31, [0119, 0145, 0149, especially **0265**, 0309 (mileage usage)]] or KLINEFELTER et al Fig. 9, col. 2, lines 38-50.

As for dep. claims 4 (part of 1), which deals with well known information/data parameter, i.e. information/data previously stored in a database, this is non-essential to the claimed invention and are fairly taught in HARDMAN et al /KLINEFELTER et al as shown in HARDMAN et al Figs. 31-33 or [0150-0150 "history data"/"Update history data"].

As for dep. claims 5-6 (part of 1), which deals with well known information/data parameter, i.e. features of the information/data previously stored in a database, these are non-essential to the claimed invention and are fairly taught in HARDMAN et al /KLINEFELTER et al as shown in HARDMAN et al Figs. 31-33 or [0150-0150 "history

Art Unit: 3629

data"/"Update history data"]. Moreover, these are non-functional language limitation, i.e. "is derived", and carry no patentable weight.

As for dep. claim 7 (part of 1), which deals with well known device parameter, i.e. type of printer and component, these are non-essential to the claimed invention and are fairly taught in HARDMAN et al /KLINEFELTER et al as shown in KLINEFELTER et al col. 1, lines 7-18.

As for dep. claim 8 (part of 1), which deals with associating certain rules (or specification or standard) to be followed, this is non-essential to the scope of the claimed invention and is fairly taught in HARDMAN et al /KLINEFELTER et al in view of HARDMAN et al [0224]. Moreover, this would have been obvious to a skilled artisan as mere applying other well known business parameters or variables since the selection of any well known business rules for compensation of irregular product or service would have been obvious, i.e. free replacement of product or service for malfunction within the 1st year of normally guaranteed performance.

As for dep. claim 9 (part of 1), which deals with other step for testing the component for defect and storing the information, this is non-essential to the claimed invention and is fairly taught in HARDMAN et al / KLINEFELTER et al by HARDMAN et al in [0234-0235].

As for Independent Method² claim 16, which is similar to claim 1 with a preamble as shown in step (d) of 1, It's rejected for the same reason set forth in claim 1 above.

As for dep. claim 17 (part of 16), which is similar to claim 1 with a limitation as shown in step (b) of 1, It's rejected for the same reason set forth in claim 1 above.

As for dep. claim 18 (part of 16), which is similar to dep. claim 6 (of 1), it's rejected for the same reason set forth in dep. claim 6 above.

As for dep. claim 19 (part of 16), which is similar to claim 1 with a limitation as shown in step (c) of 1, It's rejected for the same reason set forth in claim 1 above.

As for Independent Apparatus¹ claim 10, HARDMAN et al discloses a system comprising:

(a) a center to receive a used device replaceable component (tire) from a device of a customer, the component including memory tag integrated therewith; {see 0107, 0119, Fig. 12}}

(b) a customer database that stores customer information for multiple customers, including device and component used by the customers; {see Fig. 12, [0109, 0110, 0139]}

(c) a data transfer center wherein the data is retrieved from the component memory and stored in the customer database; and {see 0119, Fig. 12}

(d) customer center configured to provide access to the customer database so that the operator can view the device data {see 0150, Figs. 23-30}.

As for the limitation of a recycling center, this is fairly taught in [0119] wherein a tire shop or dispatch can function as recycling center. Moreover, this limitation is merely recites the function of the center which carries no patentable weight and no elemental structures with respect to the "recycling" function or "printing device" have been shown.

Art Unit: 3629

HARDMAN et al fairly teaches the method of claim 10 except for the type of the device, i.e. printing device (or printer) and (d) customer service center configured to receive calls from the customer.

In a method and apparatus for communicating between a printer/printing device and supplies using electronic memory tag (Radio Frequency (RF) communication, KLINEFELTER et al teaches the retrieving of data from component memory (tag/memory tag) of a replaceable component (toner/ink cartridge) from a device (i.e. printing device) used by a customer {see Figs. 9, 7 or col. 5, line 5 to col. 6, line 61, col. 1, lines 5-18} for diagnostics or reordering information {see col. 6, line 15}. It would have been obvious to a skilled artisan in the electronic memory tag (Radio Frequency (RF) communication technology to modify the process of HARDMAN et al by applying the same steps of electronic tag (Radio Frequency (RF)) communication management system/method to a printing device as taught by KLINEFELTER et al, which has a similar goal of communicating between a printer/printing device and supplies using electronic memory tag (Radio Frequency (RF) communication, as mere applying the same electronic memory tag (Radio Frequency (RF) communication of a replaceable components to other device to achieve similar communication results. Clearly, the mere applying the same essential retrieving, storing, associating and accessing the data steps from a memory tag of a replaceable component to/of any other device would have been obvious to a skilled artisan since the type or different function of the device is not critical and any device can be used.

Art Unit: 3629

As for the limitation of (d) customer service center configured to receive calls from the customer, this is well known business practice to improve business performance by receiving feedback from the customer as shown in Applicant's Background, pages 1-3, and would have been obvious to implement this practice in HARDMAN et al /KLINEFELTER et al to improve business performance.

As for dep. claims 11, 12 (part of 10), which have similar limitations as in dep. claims 3, 2 respectively above, they are rejected for the same reasons set forth in claims 3 and 2 above.

As for dep. claims 13, 14 (part of 10), which have similar limitations as in dep. claim 9 above, they are rejected for the same reasons set forth in claim 9 above.

As for dep. claim 15 (part of 10), which have similar limitations as in dep. claim 7 above, they are rejected for the same reasons set forth in claim 7 above.

As for independent claims 20, 25, they are rejected over the databases of HARDMAN et al /KLINEFELTER et al as shown in HARDMAN et al [0108, 0110, 0112].

As for dep. claims 21-23 (part of 20), they are rejected for the same reasons set forth above.

In Summary

6. **Note** on [0309] and [0313], HARDMAN et al discloses that any other desired device or parameters can be implemented and that other elements, steps, methods and techniques that are insubstantially different from those described herein are also within the scope of the invention. Thus, the scope of the invention should not be limited by the particular embodiments described herein but should be defined by the appended claims

Art Unit: 3629

and equivalents thereof. Changing to other type of device or component would be considered as selecting other equivalent device and component and would have been obvious, absent evidence of unexpected results.

Response to Arguments

7. Applicant's arguments, see responses, filed 3/10/05, with respect to the 103 rejections of claims 1-9, 16-19, 10-15 over HARDMAN et al in view of AAPA have been fully considered and are persuasive. These rejections of claims 1-9, 16-19, 10-15 have been withdrawn. However, a new rejection has been applied.

Art Unit: 3629


8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (571) 272-6812. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
June 13, 2005


DEANT. NGUYEN
PRIMARY EXAMINER 6/13
05